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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	M61-006-01-US	7081

7590 11/20/2006  
MACARTHUR INVESTMENTS, LLC  
C/O ANDREA-MARIE JACOBSON  
4456 PARKLAWN COURT, #306  
EDINA, MN 55435

EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3694

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/175,589	<b>Applicant(s)</b> JACOBSON	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/22/05 & 11/08/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-14,16-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-14,16-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-3, 5-14, 16-19, and 21-23 are pending. Claims 1, 13, 17, and 23 have been amended in this communication filed 11/22/05 entered as Request for Continued Examination and Amendment.
2. The request for continued suspension filed 10/17/06 has been Denied and the A/R record has been closed and the status reset.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/05 has been entered.

#### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because in **Figure 1**, reference character "105" has been used to designate both "Computers" and "processors"; reference character "130" has been used to designate "database", "memories", "memory" and "policy compliance monitor"; reference character "105" has been used to designate both "Computers" and "processors"; reference character "140" has been used to designate "Email Management System" and "document management system"; reference character "180" has been used to designate "Email Records", "Email Records Management Database" and "email

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management database”; reference character “190” has been used to designate “Electronic Contracts” and “Email Management Database”; **Figur 2B** should be **Figure 2B**, reference character “206” has been used to designate “Send Business Email” and “send original email”; reference character “208” has been used to designate “Distributed Email Message” and “Distributed Copied Email Messages”; reference character “209” has been used to designate “User 1” and “sending email”; reference character “210” should be “Convert Email Message(s)”; reference character “211” has been used to designate “Central Repository Database” and “storing email messages”; reference character “212” has been used to designate “Email Records Database” and “storing email”; **Figure 3**, reference character “341” has been used to designate “Read Recipient’s user profile” and “read recipient’s user identification number”; **Figure 3A**, reference character “352” has been used to designate “Read Network User’s Workstation Specs.” and “read network user’s workstation specification”; reference character “346” has been used to designate “Present user with central repository menu” and “present user with central repository database menu”; **Figure 3B**, Is the reference character “345A or “345” that has been used to designate “Sorting files to match header” and “sorting files to match email headers”?; **Figur 3C** should be **Figure 3C** and reference character “354” has been used to designate “Read Server log file” and “read email log file”; reference character “357” has been used to designate “Purge email message” and “purge email”; **Figure 6B**, reference character “605” has been used to designate “Read numeric valued of the reference code” and “Read numeric values of the reference code”; reference character “608” has been used to designate “Read text

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values of the reference code” and “Analyzing the text values of the reference code”; reference character “609” has been used to designate “Analyze text code to object” and “Correlate text code to object”; reference character “606” should read “User’s profile”; **Figure 6C**, reference character “614” has been used to designate “Activate message indicator” and “Activate message status indicator”; reference character “615” has been used to designate “Record user opening email” and “Record recipient’s opening email”; **Figure 6D**, reference character “625” has been used to designate “Read email log file” and “read email server log file”; **Figure 7**, reference character “701” has been used to designate “Present proposal template” and “present proposal form”; reference character “705” has been used to designate “Receive signal to send mail” and “Receive signal from user to send mail”; **Figure 7B**, reference character “709” has been used to designate “Receive auto reply” and “Receive email”. The page numbering 1-24 in the lower right corner for Figures 8A –Figure 29 needs to be removed. Corrected drawing Sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. The Specification is objected to because of the following: On Page 3 entitled "Brief Description of the Drawings", line 26 reads "Figures 6-6D are flow diagrams ...". This line should read "Figures 6 and 6B-6D are flow diagrams ..." because Figure 6A is not found. Line 28 reads "Figures 7-7B are flow diagrams ...". This line should read "Figures 7 and 7B are flow diagrams ...". Figure 7A is not found. On page 7, line 3 does not reference "The policy compliance monitor 110" and the other elements "120" and "115" as referring to Figure 1 and on page 8 the "Email Management System 140" as being in Figure 1. Page 10m line 21 in the description of Figure 5 does not refer to "the system 140 as being in Figure 1. Page 11, line 9 recites "... electronic tag may begin executing ...". This line should read "... electronic tag and may begin executing ...". Page 13, line 18 reads "... the a workstation's local machine". This line should read "... the workstation's local machine". Page 18, line 3 reads "Figure 6A-6D are flow diagrams ...". Figure 6A is not found. This line should read "Figures 6 and 6B-6D are flow diagrams ...". Page 19, line 3 reads "Block 613 ...". This line should read "Figure 6C is a continuation of the flow diagram of Figure 6B. Block 613 ..." and line 20 reads "Block 618 ...". This line should read "Block 619 ...". Page 25, line 34 reads "... message. Figure 6 is a screen display ...". Figure 6 is a flow diagram and not a screen display. Page 26, line 2 reads "... menu. Block 436 represents the". This line should read "... menu. Figure 3A is a continuation flow diagram of Figure 3. Block 346 represents the". Page 27, line 27 reads "Block 354 ...". Is this "Block 354" in Figure 3 B or in Figure 3C? Page 28, lines 24 and 25 read "... an email contact command in system 170. Block 700 ...". Element "170" is not found in the drawing Figure 1.

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"Electronic contracts Database" is element "190". Page 29, after "Block 703" in line 10, "Block 704" is missing from the description. Page 29, line 11 references "Block 1004". "Block 1004" is not found in any of the drawing figures. Line 26 reads "... screen. Block 709 represents". This line should read "... screen. In Figure 7B, block 709 represents". This clarifies that "Block 709" in Figure 7B is being referenced since elements "700, 701, 702, 703, 704 (missing), 705, 706, 707, and 708" are in Figure 7. Page 31, lines 6-26 when describing Figure 4 has elements "401, 403, 405, and 407" missing. It is suggested to have a flow diagram for a Figure 4A with these blocks starting with block 401. Either add a Figure 4A at line 22 on page 3 of the Specification or incorporate these blocks into Figure 4 where they belong. Figures 8A-8C, 9, 10, 11, 14 and 22 are not described in the Specification. Correction is required. See MPEP § 608.01(b).

A substitute specification is required pursuant to 37 CFR 1.125(a) because of the numerous errors and omissions.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification

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contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

### ***Claim Objections***

6. Claims 1, 13, 17, and 23 are objected to because of the following informalities: Claim 1, line 11 recites "... acts to keep the electronic record from being". This line would be better read as "... prevents the electronic record from being". Claims 13, 17, and 23 have a similar problem. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 13, 17, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "that correlates to scripting code" and "sending of the electronic record activates the scripting code that correlates to the electronic tag". The Specification on Page 11, lines 9-11 recites "... may read the emails electronic tag and may begin executing the scripting code within the application. Each scripting code typically correlates to an email reference code and activates an object".

The Specification on page 7, line 11 refers to "Network security policies" and the claim limitations of claims 1, 13, 17, and 23 recites "network security rules".

Claims 1 and 23 recite "pre-determined network security rules". There is not sufficient support in Applicant's Specification for this claim limitation. Nothing in Applicant's Specification states These are the "pre-determined network security rules as follows:" or the "pre-determined network security rules are ...".

The claimed new matter should either be incorporated into the Specification or cancelled from the claims or point out to the Examiner where the newly added limitations are found in Applicants' Specification.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 1 recites the limitation "pre-determined security rules". Claim 23 has a similar problem. Claim 15 recites the limitations "central repository" and "distributed computing environment". Claim 17 has a similar problem. There is insufficient antecedent basis for these limitations in the claims.

Claims 1, 13, 17, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Suggestions: Claim 1 after the first step "identifying the electronic record that correlates to the scripting code with the electronic tag; associating the electronic tag with a deletion prevention time period for compliance with predetermined security rules; storing the at least one electronic tag in the central repository; retrieving the at least one electronic tag from the central repository; sending the electronic record distributed computing environment to a

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recipient, wherein ...; (another step is needed here after the electronic record is sent to the recipient); and activating the scripting code which acts to prevent the electronic record from being deleted before expiration of the deletion prevention specified time period for compliance associated with the electronic tag". Applicant's claim limitations have a disconnect of steps. Each of the steps of the invention need a connection to other steps. Claims 13,17, and 23 have a similar problem. The last claim limitation of claim 23 has a definite disconnect to the other claim limitations and the claim limitation is in improper format for a method claim steps. The last claim limitation to be in proper method step format should recite: "monitoring compliance automatically with the network security rules as a function of the electronic tag".

### **Inquiries**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 15, 2006

  
ELLA COLBERT  
PRIMARY EXAMINER